

The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY J. WILLIAMS

Appeal 2006-2721
Application 09/579,938
Technology Center 1700

Decided: April 30, 2007

Before CHUNG K. PAK, CHARLES F. WARREN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1, 3 through 7, 9 through 11, 13 through 19, 22 through 26, and 28 through 34 in the Office action mailed June 10, 2004.¹ 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2005).

We affirm-in-part the decision of the Primary Examiner.

Claims 1 and 7 illustrate Appellant's invention of a paint storage container, and are representative of the claims on appeal:

1. A paint storage container comprising:
 - a. a plurality of paint storage compartments each for storing paint having a front, a back, a first side, a second side and a base;
 - b. a frame holding the paint storage compartments; and
 - c. means for dispensing removeably [sic] coupled to the base of the paint storage compartments for dispensing paint from the paint storage compartments, wherein the means for dispensing is capable of dispensing paint without lifting the paint compartments.
7. A paint storage container comprising:
 - a. a plurality of paint storage compartments each for storing paint having a front, a back, a first side, a second side and a base;
 - b. a frame holding the paint storage compartments;
 - c. one or more lids covering the paint storage compartments;
 - d. a stirring assembly removeably [sic] coupled to the lids for stirring the paint stored in the paint storage compartments; and
 - e. a dispensing mechanism removeably [sic] coupled to the base of the paint storage compartments to dispense paint from the paint storage compartments, wherein the dispensing mechanism is capable of dispensing paint without lifting the paint compartments.

The Examiner relies on the evidence in these references with respect to the grounds of rejection advanced on appeal:

Corbin	US 2,848,019	Aug. 19, 1958
Reed	US 4,311,017	Jan. 19, 1982
DeVito	US 5,842,606	Dec. 1, 1998
Briggs	US 6,109,482	Aug. 29, 2000

¹ Claims 20 and 27 are also of record and have been allowed by the Examiner (Office action mailed June 10, 2004, 14).

The Examiner relies on the evidence in these references with respect to claim interpretation (Answer, e.g., 3 and 5):

Moran

US 5,899,362

May 4, 1999

“Viscosity,” “Cole Palmer’s FoodTechSource” (2002) (Palmer),
http://www.foodtechsource.com/rcenter/tech_data/td_viscosity.html.

Appellant relies on the evidence in these references with respect to claim interpretation (Br.,² e.g., 8 and Evidence Appendix):

“Paint Thickness Differences,” “Airbrushing, Basic Education” (Curry),
<http://www.currys.com/knowledge/aboutairbr.html>.

“1 US Gallon Endure permanent Exterior House Paint,” “eBay” (2004) (“Endure” information),
http://www.google.com/search?q=cache:zlAWOHkFI_sJ:building-repair-materials.home-items-portal.com/1-US-Gallon-Endure-Permanent-Exterior-House-Paint-3535666.html+viscosity+%22house+paint%22+centipoise&hl=en.

Appellant requests review of the following grounds of rejection (Br. 5-6), the grounds all advanced on appeal:³

claims 29 through 33 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Answer 3-4);

claims 1, 3, 4, and 29 under 35 U.S.C. § 102(b) as anticipated by DeVito (*id.* 4-5);

claims 1, 3, 4, and 29 under 35 U.S.C. § 102(b) as anticipated by Briggs (*id.* 5-6);

claim 34 under 35 U.S.C. § 102(b) as anticipated by Corbin (*id.* 6-7);

claims 1, 3 through 7, 9 through 11, 13 through 19, 22 through 26, and 29 through 33 under 35 U.S.C. § 103(a) as being unpatentable over Reed (*id.* 8-13); and

² We consider the Brief filed October 11, 2005.

³ The ground of rejection of claims 29 through 33 under 35 U.S.C. § 112, second paragraph, is withdrawn by the Examiner (Answer 2-3; *see* Br. 5).

claims 21 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Reed in view of Briggs (*id.* 13).

Appellant argues the claims in each ground of rejection as a group, and with respect to the grounds of rejection based on prior art, further argues the independent claims separately with the respective dependent claims standing or falling therewith. Thus, we decide this appeal based on the individual claims to the extent argued by Appellant and the circumstances of the grounds of rejection admit. 37 C.F.R. § 41.37(c)(1)(vii) (2005).

With respect to the ground of rejection under § 112, first paragraph, written description requirement, the Examiner contends the claims contain the limitation “the dispensing mechanism has a size sufficient for paint to flow through,” raising “the issue of the size of the dispensing mechanism [that] is simply not discussed in the originally filed specification at all” (Answer 3-4). The Examiner contends that the relationship between the size of a dispensing mechanism and its capability to dispense paint, including “an intrinsic threshold size below which a dispensing mechanism could not dispense paint,” is not described (*id.* 13-14). Appellant contends the claim limitation requires a mechanism of a size sufficient for paint to flow there through and such size need not be stated in the Specification (Br. 6; *see also* Reply Br. 4).

With respect to the grounds of rejection under § 102(b) over each of DeVito and Briggs, the Examiner contends an apparatus disclosed by each reference meets the structural limitations of claim 1 including “means . . . for dispensing removably coupled to the base of the compartments . . . [and] capable of dispensing without lifting the compartments” (Answer 4 and 5). The Examiner contends the apparatus of each reference describes a spigot

assembly claimed as the dispensing means in claim 3 (*id.* 5 and 6). The Examiner contends the term “paint” does not distinguish the apparatus of each of the references which are described as used with beverages, finding each apparatus “capable of holding and dispensing paint” (*id.* 4-5 and 5-6). The Examiner contends “the term ‘paint’ includes liquids of similar consistency to common beverages” and “may be in the same viscosity ranges as beverages,” pointing to the disclosure of a “paint having a viscosity of ‘7 centipoise’” in Moran and the disclosure “that milk, cream and tomato juice have viscosities of 3.2, 16.5, and 176 centipoise respectively” in Palmer (*id.* 5 and 6).

Appellant contends the claims are not anticipated by each of DeVito and Briggs “since the storage compartments and dispensing mechanism for paint are inherently different than those of beverage containers” (Br. 7-8). Appellant contends “[a]s known to those skilled in the art, paint has a consistency and viscosity and will not flow through just any size opening” as “[p]aint, specifically house paint, is typically between 3,000-6,000 centipoise and sometimes upwards of 20,000 centipoise” and will not “flow through a small opening that liquids like milk or even tomato juice could flow through,” citing Curry (*id.* 8-10 and 10-12; see also Reply Br. 6). Appellant contends the invention as claimed, including claim 1, includes containers with particular shapes having “a spigot coupled to the base for dispensing” paint, citing the Abstract of the Specification, and “dispensing means . . . removeably [sic] coupled to the base,” citing page 2, lines 18-19, of the Specification, which is not shown by DeVito and by Briggs (*id.* 8-10 and 10-13).

The Examiner replies contends “none of the claims requires a capability to dispense ‘house’ paint” and “[a] capability to dispense a paint which is not ‘house’ paint would satisfy the claim limitations” (Answer 14-16 and 17-19). The Examiner contends Appellant has not supported the contention “paint will not flow through just any size opening” with respect to DeVito and Briggs (*id.*). The Examiner contends the nozzle assembly of the apparatus of each of DeVito and Briggs are removably coupled to the base of the container (*id.* 17 and 19). Appellant replies the apparatus of each of DeVito and Briggs serve drinks and do not store and dispense paint (Reply Br. 6-7).

With respect to the ground of rejection under § 102(b) over Corbin, the Examiner contends Corbin discloses a paint storage container apparatus with compartments having a dispensing mechanism removably coupled to the base of the compartments capable of dispensing paint without lifting a compartment (Answer 6-7). The Examiner contends Corbin describes the compartments as “storage reservoirs” (*id.* 19). Appellant contends Corbin discloses paint in temporary storage reservoirs for mixing and not in storage “to be used at a later date” (Br. 13; Reply Br. 7).

With respect to the ground of rejection under § 103(a) over Reed, the Examiner contends Reed would have disclosed a beverage dispensing apparatus with compartments that have a dispensing mechanism coupled to the base and are covered with lids which have a coupled stirring assembly that includes a fan (Answer 7-13). The Examiner contends that while Reed does not expressly state that the dispensing mechanism and the stirring assembly is removable as specified for the claimed apparatus encompassed

by independent claims 1, 7, 11, 16, and 22, Reed recognizes the advantages of making parts removable, citing column 5, lines 35-37 (*id.*). The Examiner contends that the apparatus of Reed is capable of stirring paint and is capable of dispensing “paint” through the dispensing mechanism without lifting the compartment (*id.*).

Appellant contends that the apparatus of Reed controls the temperature of liquids and the reference does not teach storing and dispensing paint which has a different consistency and viscosity (Br. 14-15). Appellant contends that in the claimed apparatus, the paint storage compartments have a particular downward sloping configuration with a spigot removably couple to the base thereof which is not shown in Reed (*id.*). Appellant contends “the thermoelectric jug cooler of Reed is non-analogous art to the paint storage container of the present invention” (*id.* 15). Appellant contends claim 1 requires dispensing means removably coupled to be the base of the paint storage compartments which is not disclosed by Reed (*id.* 15-16). Appellant contends claim 7 requires dispensing mechanisms removably coupled to be the base of the paint storage compartments and a stirring assembly removably coupled to the lids for the compartments which are not disclosed by Reed (*id.* 17). Appellant contends claims 11, 16, and 22 require dispensing mechanisms removably coupled to be the base of the paint storage compartments which is not disclosed by Reed (*id.* 17-18).

The Examiner responds Reed is analogous prior art because the reference and the claimed invention are concerned with mixing and dispensing liquids (Answer 20). The Examiner maintains the position that

the claim term “paint” is not limited to “house paint,” and contends Reed’s apparatus is capable of dispensing paint (*id.* 20-21). The Examiner contends Appellant has not addressed whether making the dispensing mechanism removable would have been obvious to one of ordinary skill in the art (*id.* 22). Appellant replies that the dispensing mechanism is removable in the claimed apparatus “to allow easier cleaning after use,” pointing out that paint storage devices are generally difficult to clean (Reply Br. 7-8).

With respect to the ground of rejection of dependent claims 21 and 28 under § 103(a) over Reed and Briggs, Appellant relies on the arguments advanced with respect to the rejection of independent claims 16 and 22 under § 103(a) over Reed (Br. 19).

The principle issues in this appeal are whether the Examiner has established a *prima facie* case with respect to each ground of rejection, and the underling issues include the interpretation of the claim terms “paint” and “storage” and whether the apparatus of the respective references are capable of storing and dispensing paint.

Independent claim 1 is drawn to a paint storage container apparatus comprising at least the specified components, including “means for dispensing removeably [sic] coupled to the base of the paint storage compartments for dispensing paint . . . without lifting the paint compartments.” Claim 5 specifies the paint storage container of claim 1 further comprising at least, *inter alia*, “means for stirring removeably [sic] coupled to the lids for stirring the paint stored in the paint storage compartments.”

The “means for” language in claims 1 and 5 specify a function without defining structure satisfying that function and thus, the strictures of 35 U.S.C. § 112, sixth paragraph, apply. *See Texas Digital Sys., Inc. v. Telegenx, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir. 2002), and cases cited therein. Therefore, these clauses must be limited to the “corresponding structure” disclosed in the written description in the specification and “equivalents” thereof.⁴ *In re Donaldson Co.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*in banc*) (“[T]he ‘broadest reasonable interpretation’ that an examiner may give means-plus-function language is that statutorily mandated in [35 U.S.C. § 112,] paragraph six.”).

⁴ The “corresponding structure” is that “structure in the written description necessary to perform that function [citation omitted],” that is, “the specification . . . clearly links or associates that structure to the function recited in the claims.’ [Citation omitted.]” *Texas Digital Sys.*, 308 F.3d at 1208, 64 USPQ2d at 1822-23. “[A] section 112, paragraph 6 ‘equivalent[]’ . . . [must] (1) preform the identical function and (2) be otherwise insubstantially different with respect to structure. [Citations omitted.]” *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000). “[T]wo structures may be ‘equivalent’ for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result. [Citations omitted.]” *Kemco Sales*, 208 F.3d at 1364, 54 USPQ2d at 1315. The examiner should not confuse “impermissibly imputing limitations from the specification into a claim with properly referring to the specification to determine the meaning of a particular word or phrase recited in a claim. [Citations omitted.]” *Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850; *see*

In order to establish a prima facie case of anticipation and of obviousness of claim 1 and a prima facie case of obviousness of claim 5, the Examiner must first interpret the “means for” language because all of the claim limitations must be considered. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection “every limitation in the claim must be given effect rather than considering one in isolation from the others.”); *cf. Donaldson*, 16 F.3d at 1195-97, 29 USPQ2d at 1850-52.

Here, the Examiner has not interpreted the “means for” language in claims 1 and 5 with respect to the “corresponding structure” in the Specification and “equivalents” thereof in a manner consistent with statutory requirements necessary to establish a prima facie case of anticipation of claim 1 and claims 4 and 29 dependent thereon, and a prima facie case of obviousness of claim 1 and claims 4 through 6 and 29 dependent thereon.

Accordingly, in the absence of a prima facie case of anticipation and of obviousness in these respects, we reverse the grounds of rejection of claims 1, 4 through 6 and 29.

Claim 3, dependent on claim 1, specifies “the means for dispensing paint includes a spigot assembly.” The term “spigot assembly” provides structure for the dispensing function specified in claim 1 of any assembly of any parts which together function as a spigot or faucet, that is, regulate the flow of a liquid. The claim term “dispensing mechanism” in claim 7 and

also In re Morris, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) (explaining *Donaldson*).

other independent claims, includes any manner of spigot assembly. Indeed, Appellant discloses “any known spigot or dispensing assembly 100 may be used to dispense paint from the paint storage container 48, including a lever type spigot assembly” (Specification 10:6-10). The Examiner properly considered claim 3 and the remaining appealed claims in this manner (Answer, e.g., pages 5, 6, and 8).

The term “paint” is used in the claims to characterize the capability of the storage container, storage compartments of the container, the dispensing mechanism, and stirring assembly to store, dispense, and stir the same. Thus, we give the term “paint” the broadest reasonable interpretation in ordinary usage in context as it would be understood by one of ordinary skill in the art, in light of the written description in the Specification unless another meaning is intended by Appellant as established therein, and without reading into the claim any disclosed limitation or particular embodiment. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1666-67 (Fed. Cir. 2000); *Morris*, 127 F.3d at 1054-55, 44 USPQ2d at 1027; *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Appellant discloses that “when painting the interior or exterior of a house, a person . . . is typically left with at least one partially filled can of left over paint” (Specification 1:10-14). No specific definition or other description of such “paint” is disclosed. The term “paint” has the customary, dictionary meaning of “[a] liquid mixture, usually of a solid

pigment in a liquid vehicle, used as a decorative or protective coating.”⁵ Indeed, we notice that different types of “paint” with viscosities depending on composition for a desired effect, are commonly used for decorative or protective coatings on the interior and exterior surfaces and fixtures of a house. The range of such paints includes so called “airbrush” paints of low viscosity to highly viscous “house” paints. Indeed, Curry, supplied by Appellant, discloses commercially available “ready to spray” airbrush paint for “illustration and fine art” having a viscosity of 40-60 Centipoise (cPs) and further that “[a] typical house paint is 3000-6000 cPs.”

Thus, we agree with the Examiner’s position and interpret the bare term “paint” as used in the claims to include any manner of “paint,” viscosity notwithstanding, that can be retained in a compartment of a container and dispensed therefrom to any extent with any dispensing mechanism, including any spigot assembly, and can be stirred with any manner of stirring assembly.

We interpret the claim terms “storage,” “stored” and “storing” used in the appealed claims on the same basis. These terms are used to characterize the capability of the storage container and storage compartments and are not specifically defined or otherwise describe in the written description in the Specification. The base term “store” has the customary, dictionary meaning in context of “[a] stock or supply reserved for future use.”⁶ In the absence of a time limitation with respect to “storage,” any residence time of the paint

⁵ See, e.g., **paint**, *The American Heritage Dictionary Of The English Language* 1263 (4th ed., Boston, Houghton Mifflin Company. 2000).

in the storage compartment, however brief, satisfies the language of the claims.

We agree with the Examiner's findings with respect to the beverage dispensing apparatus described in DeVito and in Briggs, including the nozzle assembly removably coupled to the base of the container (Answer 4, 5, 17 and 19). We find lever type spigot assembly 52 having lever 68 and nozzle 66 disclosed in DeVito (DeVito, e.g., col. 5, ll. 52-67, and Figs. 1-5). We find spigot 18 with valve mechanism 22 having push button 30 and spigot 39 which operates in similar manner disclosed in Briggs (Briggs, e.g., col. 4, l. 19, to col. 5, l. 13, and Figs. 1, 3, 5, and 6).

We agree with the Examiner's findings with respect to the apparatus for mixing paint having paint storage reservoirs and a dispensing mechanism removably coupled to the reservoirs described in Corbin (Answer 6-7 and 19).

We agree with the Examiner's findings with respect to the teachings of a liquid dispensing apparatus having a lid with a stirring device coupled thereto and a dispensing mechanism coupled to the base of the compartments disclosed in Reed (Answer 7-13). We find that one of ordinary skill in this art would have found in Reed's Fig. 3 an illustration of spigot 16 secured to vessel 24 by a nut that would be removable as the Examiner contends (Answer 7). We find Reed discloses at col. 5, lines 35-37, "each vessel and its spigot can be . . . removed for cleaning and/or refilling" as the Examiner contends (Answer 7). We find that vessels 24,27

⁶ See, e.g., **store**, *The American Heritage Dictionary Of The English Language* 1708.

have downward slopping sides and spigots 15,16 located near or from the base to permit dispensing of liquid into a glass, wherein the spigots include valves 7,8 and levers 13,14 (Reed, e.g., col. 5, ll. 11-37, and Figs. 1 and 3). We find the stirring devices extend through the lids of vessels 24,27 and can include rods 112 with a plurality of vanes 113 (Reed, e.g., col. 5, l. 50, to col. 6, l. 47, and Figs. 2, 5, and 6).

With respect to the ground of rejection under § 112, first paragraph, written description requirement, the Examiner has not set forth evidence or reasons why, as a matter of fact, the written description in Appellant's disclosure would not reasonably convey to persons skilled in this art that Appellant was in possession of the invention defined by the claims, including all of the limitations thereof, at the time the application was filed. *See, e.g., In re Alton*, 76 F.3d 1168, 1172, 1175-76, 37 USPQ2d 1578, 1581, 1583-84 (Fed. Cir. 1996) (citing *In re Wertheim*, 541 F.2d 257, 262-64, 191 USPQ 90, 96-97 (CCPA 1976)). Indeed, the Examiner's argument is premised on lack of enablement for the claimed apparatus, and as Appellant contends, the dispensing mechanism as claimed must only permit a paint to flow there through. The determination of the size of the dispensing mechanism necessary for any particular paint is within the ordinary skill in this art and need not be specifically set forth in the Specification. *See, e.g., In re Howarth*, 654 F.2d 103, 105, 210 USPQ 689, 691 (CCPA 1981) ("An inventor need not . . . explain every detail [of the invention] since he is speaking to those skilled in the art. What is conventional knowledge will be read into the disclosure.").

Accordingly, in the absence of a prima facie case, we reverse the rejection of claims 29 through 33 under 35 U.S.C. § 112, first paragraph, written description requirement.

With respect to the grounds of rejection under § 102(b) over DeVito and over Briggs, the Examiner has established that prima facie, each and every element of the claimed apparatus encompassed by claim 3, arranged as required by the claim, is found in each reference, either expressly or under the principles of inherency. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997), and cases cited therein. Appellant has not supported his contentions that neither DeVito nor Briggs describes an apparatus having the structural components as claimed by pointing to errors in the findings made by the Examiner with respect to the disclosure of these references. Appellant's sole contention in this respect, that the spigots in both references are not removably coupled to the base of the compartments, is contrary to teachings of the references as the Examiner points out. Appellant further has not carried the burden of establishing by convincing argument or evidence the contentions that the compartments for liquids and the dispensing mechanisms described in the references are inherently incapable of "storing" to any extent and dispensing any "paint" as we have interpreted these claim terms above. *See, e.g., Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432, and cases cited therein. Thus, on this record, we are of the opinion that appellants have identified a new intended use for an old apparatus known in the art for holding and dispensing liquids

which does not make that apparatus again patentable. *See, e.g., Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431.⁷

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of anticipation found in DeVito and in Briggs with Appellant's countervailing evidence of and argument for non-anticipation and conclude that the claimed invention encompassed by appealed claim 3 would have been anticipated as a matter of fact under 35 U.S.C. § 102(b).

With respect to the grounds of rejection under § 102(b) over Corbin, the Examiner has established that *prima facie*, each and every element of the claimed apparatus encompassed by claim 34, arranged as required by the claim, is expressly found in the reference. *See, e.g., Schreiber*, 128 F.3d at 1477, 44 USPQ2d at 1431. We are not convinced otherwise by Appellant's contention because, as the Examiner finds, Corbin describes an apparatus meeting all of the claim limitations including having "storage reservoirs" for "paint" with dispensing mechanisms for the paint coupled to the storage compartments. We note the language indicating the presence of "one or more colors of paint" in claim 34 is a recitation of a material element on which the apparatus works and does not form part of the apparatus. *See generally, In re Otto*, 312 F.2d 937, 939-40, 136 USPQ 458, 459-60 (CCPA 1963); *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935); *In re Rishoi*, 197 F.2d 342, 344-45, 9 USPQ 71, 72-73 (CCPA 1935); *cf. Ex parte Masham*, 2 USPQ2d 1647, 1648 (Bd. Pat. App. & Int. 1987).

⁷ We note that, as the Examiner argues, the issue of analogous art is irrelevant in the context of whether a reference anticipates the claimed

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of anticipation found in Corbin with Appellant's countervailing evidence of and argument for non-anticipation and conclude that the claimed invention encompassed by appealed claim 34 would have been anticipated as a matter of fact under 35 U.S.C. § 102(b).

With respect to the grounds of rejection under § 103(a) over Reed, the Examiner has established that prima facie, one of ordinary skill in the art would have modified the vessels or storage compartments of the apparatus of Reed to make the stirring devices or assemblies and the spigots or dispensing mechanisms removably coupled to the lids of the vessels and the base of the vessels, respectively, in the reasonable expectation of removing the same for cleaning. *See, e.g., B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) ("When obviousness is based on a particular prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. This suggestion or motivation need not be expressly stated." (citation omitted)).

We agree with the Examiner that Reed is analogous prior art with respect to the claimed apparatus. Indeed, Reed "is reasonably pertinent to the particular problem with which the inventor is involved," that is, to the storage and dispensing of a liquid, and thus "is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." *In re Clay*, 966 F.2d 656,

invention. *See, e.g., Schreiber*, 128 F.3d at 1478, 44 USPQ2d at 1432.

659-60, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). We further agree with the Examiner that the apparatus taught by Reed would be capable of storing and dispensing “paint” as we have interpreted this claim term above, and Appellant has not established otherwise. We also agree with the Examiner that Appellant’s contentions to the effect that the compartments of Reed’s apparatus do not have the claimed removable parts coupled with Appellant’s reason for having such parts, does not constitute effective argument establishing that one of ordinary skill in this art would not have modified Reed’s apparatus in this respect. Indeed, Reed would have reasonably suggested to this person that removable parts facilitate cleaning, which is the same reason for removability stated by Appellant, and indeed, illustrates that the spigots are removably coupled to the base of the vessels with a nut.

We noted above that Appellant relies on the same contentions with respect to the ground of rejection based on the combination of Reed and Briggs.

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in Reed and in the combination of Reed and Briggs with Appellant’s countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 3, 7, 9 through 11, 13 through 19, 21 through 26, and 28 through 33 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The Primary Examiner’s decision is affirmed-in-part.

Appeal 2006-2721
Application 09/579,938

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2005).

AFFIRMED-IN-PART

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Haverstock & Owens LLP
162 North Wolfe Road
Sunnyvale, CA 94086